

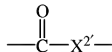
REMARKS

The claims have been presented for the convenience of the Examiner. No amendments have been proposed. Claims 1-5, 7 and 9-16 are directed to a method to treat pain. Claims 19-31 are directed to compounds *per se* and their pharmaceutical compositions. Claims 16 and 29 (and dependent claim 31) set forth specific compounds. These claims are allowed. Claims 15 and 28, which limit Ar to optionally substituted pyrimidyl, pyridyl, benzothiazole, benzimidazole or indole are considered to contain allowable subject matter as well.

Applicants appreciate the indication of allowability of these claims, but respectfully believe that the rejection of the remaining claims is in error for the reasons that follow.

The Rejection for Anticipation

Claims 19-27 and 30-31 (sic, 30) were rejected as assertedly anticipated by Registry No. STNRN85816-08-6. The structure of this compound is shown on the attachment to the Office action. Respectfully, it is believed that this rejection is in error. The linker in the compound of formula (3) shown in claim 19 between the piperazine ring and the benzhydryl moiety is



The linker between these moieties in the Registry compound is $\text{---}(\text{CH}_2)_5\text{---}$.

Thus, the compounds are not identical. All of the remaining rejected claims, claims 20-27 and 30, are dependent on claim 19. Since claim 19 is not anticipated by the Registry compound, these claims are not anticipated either. Withdrawal of this basis for rejection is respectfully requested.

Claims 1-5, 7 and 10-14 were rejected as assertedly obvious over Van Daele (U.S. 4,766,125). The Examiner is correct that instances are included in Van Daele where the R group of Van Daele can include a linked benzhydryl moiety. However, claims 1-5, 7 and 10-14 are not directed to the compounds *per se*, but are rather directed to methods to treat pain. The compounds of Van Daele are said to increase the oxygen tension of the coronary sinus venous blood when injected intravenously (column 16, lines 66, *et seq.*) and there is no teaching that they are useful in treating pain.

The only reference in Van Daele to use as a local anesthetic is in column 1, lines 24-25, which refers to a different set of compounds (N-aryl-4-)4,4-diaryl-butyl-1 piperazine alkanamides, not to the compounds shown in the Van Daele patent. As stated in column 1, line 31, the compounds of the Van Daele invention differ from these prior art compounds by the nature of the substituents on the piperazine moiety and by their pharmacological properties.

Therefore, the structures set forth in Van Daele do not suggest the method of the present invention for treating pain. Thus, claims 1-5, 7 and 9-14 to methods for treating pain using the compounds of formula (1) are not suggested by Van Daele and this basis for rejection may be withdrawn.

Conclusion

Applicants appreciate the indication of allowability of claims 15-16, 28-29 and 31. However, applicants believe that the rejection for anticipation of the claims directed to compounds by a Registry formula is in error because the claimed compounds all require a carbonyl group in the linker between benzhydryl and piperazine and there is no carbonyl group in the Registry compound

